

RESPONSE TO OFFICE ACTION

A. Status of the Claims

Claims 1-26 were filed and are presented for reconsideration.

B. Objection to the Specification and Claims

(1) The specification is objected to for including blank lines. In response, Applicant notes that a deposit of 2,500 seeds of the claimed variety will be made with the ATCC in accordance with all of the relevant rules and that the specification will be amended to include the corresponding accession number and date of deposit in place of the blank lines.

(2) The Action objects to claims 3 and 4 as not further limiting the claims from which they depend. Applicants traverse as the claims are further limiting. For example, claim 3 requires that the population of seed of claim 2 further be “an essentially homogeneous population of seed.” Claim 4 further requires that the population of seed of claim 2 be “essentially free from hybrid seed.” Nothing in claim 2 requires these elements. Rather the population merely needs to be “[a] population of the seed of claim.” Nothing would require a population of seed according to claim 1 to be absolutely homogenous or completely free of some contaminating hybrid seed. For example, the relevant definition of “population” from the on-line version of the Merriam-Webster™ dictionary is “a body of persons or individuals having a quality or characteristic in common.” In contrast, the definition for “homogeneous” from the same on-line dictionary is given as “of uniform structure or composition throughout.” Therefore a collection of seed may at one time have a quality or characteristic in common, *e.g.*, be of a given variety, yet not be of uniform structure or composition throughout. A population

can also contain contaminants. This is no different than claiming compositions comprising different specified purities of active ingredient. Claims 3 and 4 are therefore in proper dependent form and not indefinite. Withdrawal of the objection is thus respectfully requested.

(3) The Action objects to claims 10 and 18 as in improper dependent form for not limiting the claims from which they depend. In response, Applicants traverse as the acceptability of this claim format has already been acknowledged by the Board of Patent Appeals in an application presenting the same operative facts as the current case. In particular, in Appeal No. 2005-0396, Application No. 10/077,589, the same issue was raised and reversed by the Board. In that case claim 16 read as follows “16. The corn plant of claim 15, further comprising a nuclear or cytoplasmic gene conferring male sterility.” The Examiner, as here, asserted that the claim was non-limiting and inconsistent with the claim from which it depended, although in the context indefiniteness. The Board rejected this rationale, reversing the rejection and stating that:

For example, claim 16 reads on a corn plant capable of expressing all the physiological and morphological characteristics of the corn variety I180580, further comprising a nuclear or cytoplasmic gene conferring male sterility. In our opinion, the claims reasonably apprise those of skill in the art of their scope. *Amgen*, As set forth in *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985), ‘[i]f the claims, read in the light of the specifications, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more.’ Accordingly we reverse the rejection of claims 16 and 27-30 under 35 U.S.C. § 112, second paragraph.

Decision at p. 12

As explained by the Board, the claim format is perfectly acceptable, and “[i]f the claims, read in the light of the specifications, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the

subject matter permits, the courts can demand no more.” In view of the Board’s decision on this issue, withdrawal of the objection is respectfully requested.

C. Rejection of Claims Under 35 U.S.C. §112, First Paragraph - Enablement

The Action rejects claims 1-26 under 35 U.S.C. §112, first paragraph, as lacking enablement based on the absence of a seed deposit. In response, Applicants note that, as indicated in the Action, a deposit of 2,500 seeds of the claimed variety was not made as of the filing date but will be made with the ATCC in accordance with 37 C.F.R. §1.804 and all of the remaining relevant rules. A declaration certifying that the deposit meets the criteria set forth in 37 C.F.R. §1.801-1.809 will be provided and the claims amended to recite the corresponding accession number. The specification will also be amended to include the accession number of the deposit and the date of deposit.

In view of the foregoing, removal of the rejection is respectfully requested.

D. Rejection of Claims Under 35 U.S.C. §112, Second Paragraph

The Action rejects the claims under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out the subject matter which Applicants regard as the invention. The individual rejections and Applicants’ responses thereto are set forth below.

(1) The Action rejects the claims for lack of deposit information in place of blank lines. In response, Applicant notes that a deposit of 2,500 seeds of the claimed variety will be made with the ATCC in accordance with all of the relevant rules and that the claims will be amended to recite the accession number of the deposit. The rejection is therefore believed moot and removal thereof is thus respectfully requested.

(2) In claims 20 and 25 it is stated that the reference to a plurality of paired chromosomes, genetic loci and corn plants comprising these is indefinite because it is unclear if there are additional chromosomes or genetic loci. In response Applicants note that the terms are present to serve as an antecedent basis, for example, for the plants defined by the claims. The terms are not intended to indicate that any particular additional loci or chromosomes need be present. Therefore, while some of the elements may be inherent, their use in the claim is proper under §112 and adds clarity to the claim. Withdrawal of the rejection is thus respectfully requested.

E. Rejection Under 35 U.S.C. §102(b)

The Action rejections claim 24, individually, as anticipated by several references said to teach some of the traits of the claimed variety. In particular, it is asserted that the claim could read on prior art plants because the method of producing a converted plant would allegedly not distinguish the plant. Applicants traverse.

Applicants respectfully traverse as no showing that the cited references actually do teach the claim limitations or for concluding that such properties are inherent has been made. No basis for shifting the burden on the Applicants has therefore been shown because the claims fully distinguish over the prior art. For example, a review of the morphological descriptions of the cited varieties relative to the current description reveals that the cited and current varieties differ in numerous traits, including many non-quantitative traits with minimal environmental influence, if any. There is simply no basis to conclude that the cited plants could be capable of expressing the traits of the exemplified variety under any environmental conditions. There is therefore no basis to conclude the claims read on the prior art or to shift the burden to Applicants.

Hypothetical possibilities do not suffice to support a prior art rejection. The claimed subject matter has been fully defined over the art. In contrast, the Action appears to be alleging that the cited plants *may* be the same as the claimed subject matter. However, other than the recitation of a few selected traits, the Action made no attempt to show that the cited varieties anticipate the subject matter of the claims. Under 35 U.S.C. § 102 it is the burden of the Office to show that *each and every* element as set forth in the claim is found in the prior art. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). This has not been done and the anticipation rejection must therefore fail.

To the extent that unexpressed inherent characteristics of the cited variety form the basis of the anticipation rejection, it is noted by Applicants that these characteristics must necessarily flow from the prior art. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) ("To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill."). Here, it is merely stated that the cited varieties share *some* of the same characteristics and there is no showing that any other traits *are* necessarily present. The Action has thus failed to meet the burden under 35 U.S.C. §102 or §103.

Finally, Applicants note that a rejection must be supported by “substantial evidence” in accordance with the Administrative Procedure Act (“APA”). 5 U.S.C. § 706(A), (E), 1994; *see also In re Zurko*, 59 USPQ 2d 1693 (Fed. Cir. 2001). The current rejection is not properly supported because it is based on hypothetical possibilities. The burden has further not been shifted to Applicants because the claims define over the prior art as set forth above. No basis for the rejection has therefore been provided or exists. Withdrawal of the rejection is thus respectfully requested.

F. Conclusion

This is submitted to be a complete response to the referenced Office Action. In conclusion, Applicant submits that, in light of the foregoing remarks, the present case is in condition for allowance and such favorable action is respectfully requested.

The Examiner is invited to contact the undersigned at (512) 536-3085 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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